

REMARKS

This paper is filed in response to the final Office action mailed on November 13, 2009. In that Office action, claims 1, 2, 19-25 and 29 are rejected under 35 U.S.C. §102(b) as being purportedly anticipated by prior art; and claims 3-18 and 26-28 are rejected under 35 U.S.C. §103(a) as being purportedly obvious in view of prior art. In response to the Office action and to further distinguish the present application from the prior art, claims 1 and 19 have been amended. Claim 30 is newly added. No new matter has been added. In light of the foregoing amendments and following remarks, applicants respectfully request reconsideration and allowance of all pending claims.

In the outstanding Office action, claims 1, 2 and 19 stand rejected as being anticipated by U.S. Patent No. 5,259,957 ("Rosenfeld"); and claims 19-25 and 29 stand rejected as being anticipated by U.S. Patent No. 6,325,909 ("Li"). However, to anticipate a claim, MPEP §2131 requires that a single prior art reference must disclose each and every limitation of the claim. Applicants submit that each of the pending claims includes one or more elements that are not disclosed by Rosenfeld or Li, thereby overcoming the aforementioned rejections, as discussed more specifically below.

Independent claim 1, as well as claims 2-18 dependent thereon, specifies a process for fabricating electronic components in which a support material with first and second surfaces is anodized. Among other things, claim 1 requires a first anodizing operation and a second anodizing operation. The first anodizing operation is carried out along a first direction on the first surface of the support material in order to form at least one first pore that extends along the first direction in the support material. The second anodizing operation is carried out along a second direction in order to form at least one second pore on the second surface that extends in the support material along the second direction. As currently amended, claim 1 additionally requires that the second anodizing operation is carried out along a second direction on the second surface. Support for the same is found, for example, in Fig. 1-7 and paragraphs [0055]-[0056] of the present application, Publication No. 2007/028135, corresponding thereto. No new matter has been added.

Independent claim 19, as well as claims 20-29 dependent thereon, similarly specifies an electronic component that is obtained by a process in which support material with first and second surfaces is anodized. In addition to the limitations of claim 1, claim 19 requires that the electronic component comprises an element of support material with at least

one first pore that extends along a first direction and at least one second pore that extends along a second direction. As currently amended, claim 19 further specifies that the first pore extends from the first surface and that the at least one second pore extends from the second surface. Support for the same is found in Fig. 1-7 and paragraphs [0055]-[0056] of the present application corresponding thereto. No new matter has been added.

As in claims 1 and 19, newly added independent claim 30 specifies an electronic component that is obtained by a process in which a support material having first and second surfaces is anodized. Among other things, claim 30 further incorporates the limitations of pending claims 19, 20, 24 and 26-28. Accordingly, support for the same is found throughout the application. No new matter has been added.

Rosenfeld fails to disclose such elements. With reference to Figs. 1 and 2, column 3, lines 31-44 of Rosenfeld teaches a first anodizing operation as being carried out on a surface 14 so as to create a pore 12. However, Rosenfeld does not teach a second anodizing operation that is carried out on a second surface. In Rosenfeld, the first anodizing operation is continued, with different parameters, so as to create branched pores 15 within the pores 12. The branched pores 15 ultimately reach a lower surface (not numbered) of the support material 10 that is opposite to the surface 14. Accordingly, Rosenfeld teaches a continuous anodizing operation so as to create second pores within the first pore which extend along a different direction. Nothing in Rosenfeld teaches a process comprising a second anodizing operation that is carried out on the second surface, as required by the amended claims. Furthermore, applicants note that it is not possible to perform a second anodizing operation on the second surface of Rosenfeld because of the substrate 11. As Rosenfeld fails to teach a second anodizing operation that is carried out on a second surface, as required by amended claims 1 and 19, the anticipation rejection of claims 1, 2 and 19 based upon Rosenfeld also must fail and should be withdrawn.

Li similarly fails to disclose all of the limitations of the pending claims as currently amended. More specifically, the second pore of Li does not extend from any surface. In contrast, the second pore of Li extends from the first pore. As Li fails to teach a first pore which extends from a first surface along a first direction and a second pore which extends from a second surface along a second direction, as required by amended claim 19, the anticipation rejection of claims 19-25 and 29 based upon Li must also fail and should be withdrawn.

Furthermore, claims 3-18 and 26-38 stand rejected under 35 U.S.C. §103 as being purportedly obvious over combinations of the cited prior art. Specifically, claims 3-9 and 13-18 stand rejected over Rosenfeld in view of Li; claims 10-12 stand rejected over Rosenfeld in view of U.S. Patent Application No. 2002/0130311 ("Lieber"); and claims 26-28 stand rejected over Li in view of Lieber. However, to support an obviousness rejection, MPEP §2143.03 requires "all words of a claim to be considered" and MPEP §2141.02 requires consideration of the "[claimed] invention and prior art as a whole." Further, the Board of Patent Appeals and Interferences recently confirmed that a proper, post-*KSR* obviousness determination still requires the Office to make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." See, *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Applicants submit that none of the proposed combinations of the prior art discloses every limitation of the pending claims, thereby overcoming the aforementioned rejections, as discussed more specifically below.

The Examiner asserts that claims 3-9 and 13-18 are obvious in view of the combination of Rosenfeld and Li. However, each of Rosenfeld and Li has been previously discussed as failing to teach all of the elements of the pending claims as currently amended. Specifically, Rosenfeld has been shown to lack at least a second anodizing operation that is carried out on a second surface. Li has similarly been shown to lack a first pore which extends from a first surface along a first direction and a second pore which extends from a second surface along a second direction. Accordingly, the combination of Rosenfeld and Li still fails to teach or suggest at least a second anodizing operation that is carried out on a second surface or a second pore which extends from a second surface along a second direction. Furthermore, there is no suggestion in the prior art to perform anodizing operations on different surfaces of a support material so as to form pores extending in different directions as claimed. There is also no suggestion in the prior art to provide an electronic component obtained by the claimed process having pores extending from surfaces along distinct directions. In particular, Rosenfeld is not directed to an electronic component, but rather, to a membrane for a separation device. As the combination of Rosenfeld and Li fails to teach or suggest all of the elements of the pending claims, the obviousness rejection of claims 3-9 and 13-18 based upon Rosenfeld and Li must also fail and should be withdrawn.

The Examiner additionally asserts that claims 10-12 are obvious in view of the combination of Rosenfeld and Lieber. Rosenfeld has been previously discussed as failing to

teach or suggest at least a second anodizing operation that is carried out on a second surface. Lieber similarly fails to supply Rosenfeld with a second surface upon which a second anodizing operation is executed. Accordingly, as the combination of Rosenfeld and Lieber fails to teach or suggest all of the elements of the pending claims, the obviousness rejection of claims 10-12 based upon Rosenfeld and Lieber must also fail and should be withdrawn.

The Examiner also asserts that claims 26-28 are obvious in view of the combination of Li and Lieber. Li has been previously discussed as being deficient for lacking a first pore which extends from a first surface along a first direction and a second pore which extends from a second surface along a second direction. Lieber similarly fails to supply all of the deficiencies of Li. As the combination of Li and Lieber fails to teach or suggest all of the elements of the pending claims, the obviousness rejection of claims 26-28 based upon Li and Lieber must also fail and should be withdrawn.

Based on all of the above, each of the pending claims is in condition for allowance and applicants respectfully request same. Should the Examiner have any questions, he is invited to telephone the undersigned.

Dated: February 10, 2010

Respectfully submitted,

By 

Robin S. O

Registration No.: 60,043
MILLER, MATTHIAS & HULL
One North Franklin Street
Suite 2350
Chicago, Illinois 60606
(312) 977-9902
Agent for Applicant